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OFFICE OF PETITIONS

In re
Ono, et al.
Application No. 09/850,167
Filed: May 8, 2001
Patent No. 6,712,896
Issued: March 30, 2004

:
: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT
: AND
: NOTICE OF INTENT TO ISSUE
: CERTIFICATE OF CORRECTION

This is a decision on the "COMMENT ON DETERMINATION OF PATENT TERM ADJUSTMENT", filed December 12, 2003 and the "APPLICATION FOR PATENT TERM ADJUSTMENT," filed April 22, 2004. Applicants request that the patent term adjustment under 35 U.S.C. 154(b) be corrected from twenty-one (21) day to seventy-seven (77) days.

The application for patent term adjustment is **GRANTED**.

The patent term adjustment indicated on the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **seventy-seven (77) days**.

On September 16, 2003, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term

adjustment (PTA) to date was one hundred thirty-one (131) days. Applicants timely filed the "COMMENT ON DETERMINATION OF PATENT TERM ADJUSTMENT" on December 12, 2003.¹ On March 30, 2004, the above-identified application matured into U.S. Patent No. 6,647,316. The patent issued with a Patent Term Adjustment of twenty-one (21) days.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office determined a patent term adjustment of twenty-one (21) days based on an adjustment for PTO delay of seventy-seven (77) days pursuant to 35 U.S.C. §154(b)(1)(A)(i) and 37 C.F.R. §1.703(a)(1), and eighteen (18) and thirty-six (36) days pursuant to 35 U.S.C. §154(b)(1)(A)(ii) and 37 C.F.R. §1.703(a)(2), reduced by applicants' delay of one hundred ten (110) days pursuant to 35 U.S.C. §154(b)(2)(C)(ii) and 37 C.F.R. §1.704(c)(10). The PTO delay of 77 days has been reviewed and found to be correct. The adjustments of 18, 36, and 110 days are at issue.

The adjustment of 18 days has been found to be incorrect. A review of the file reveals that Applicants filed a "RESPONSE TO RESTRICTION REQUIREMENT" on December 23, 2002. In response, the PTO mailed an Office action on March 11, 2003. As this was within the four month period pursuant to 37 C.F.R. §1.703(a)(2), no PTO delay should have been assessed.

Similarly, the adjustment of 36 days has also been found to be incorrect. Applicants filed an amendment on July 22, 2003. In response, the PTO mailed a Notice of Allowance on September 16, 2003. As this was within the four month period pursuant to 37 C.F.R. §1.703(a)(2), no PTO delay should have been assessed.

Lastly, Applicants were assessed delay of 110 days for the filing of "COMMENT ON DETERMINATION OF PATENT TERM ADJUSTMENT". However, pursuant to 37 C.F.R. §1.704(e), the submission of an application for patent term adjustment is not considered a failure to engage in reasonable efforts to conclude prosecution of the application. Accordingly, Applicants should have incurred no delay for this filing.

In view thereof, issuance of a certificate of correction pursuant to 35 U.S.C. §254 and 37 C.F.R. §1.322 is appropriate.

¹ The application for patent term adjustment was filed on the same date as the issue fee.

The \$200 fee set forth in 37 C.F.R. §1.18(e) for the "COMMENT ON DETERMINATION OF PATENT TERM ADJUSTMENT" has been charged to Deposit Account No. 06-0916, as authorized. However, the \$200 fee for the "APPLICATION FOR PATENT TERM ADJUSTMENT" under 37 C.F.R. §1.705(d) is being waived by the Office.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify the error regarding the patent term information. See 35 U.S.C. §254 and 37 C.F.R. §1.322. The certificate of correction will indicate that the term of the above-identified patent is extended or adjusted by **seventy-seven (77) days** subject to any disclaimers.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

*Karin Ferriter
per*

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Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Draft Certificate of Correction